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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/402,936	01/03/2000	THOMAS G. WILSON	082584/0107	6645

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EXAMINER

GUZO, DAVID

ART UNIT

PAPER NUMBER

1636

DATE MAILED: 01/28/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/402,936

Applicant(s)

WILSON ET AL.

Examiner

David Guzo

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 October 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-51 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-51 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- ☐ Interview Summary (PTO-413) Paper No(s) _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

Election/Restriction

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 1-14, 18-28, 29 and 42-51, drawn to isolated polynucleotides, an expression vector comprising the polynucleotides, host cells containing the vectors, a screening method and a method of use of said polynucleotides to express the polypeptides encoded by the polynucleotides.

Group II, claim(s) 15-17, drawn to polypeptides.

Group III, claim(s) 30-31, drawn to a method for detecting JH-resistant individuals.

Group IV, claim(s) 32-41, drawn to in vivo methods for screening compounds that bind a bHLH-PAS/JHR polypeptide.

The inventions listed as Groups I-V do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: The special technical feature of Group I that defines an advance over the prior art is the polynucleotide sequence(s) encoding a bHLH-PAS polypeptide. Each of the other groups is characterized by a special technical feature which defines an advance over that of group I. The special technical feature of Group II is the polypeptide sequence of the bHLH-PAS polypeptide; this feature defines an advance over group I because it is a materially distinct product having unique properties and uses which is not obvious over the polynucleotides of group I. The special technical feature of group III is a method for detecting JH-resistant insects comprising detecting a nucleic acid sequence within a polynucleotide sequence encoding a bHLH-PAS polypeptide that is altered in JH analog resistant individuals. The special technical feature which distinguishes over group I is the detection of altered bHLH-PAS polynucleotides which are present in JH resistant insects. The special technical feature of group IV involves a screening method utilizing a fusion protein comprising a bHLH-PAS polypeptide and a second polypeptide comprising a DNA binding domain. The fusion polypeptides are distinct molecules which are not obvious over the polynucleotides of group I or the polypeptides of group II. Additionally, the methods of groups III and IV are distinct in that each involves

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different, unrelated, methodologies and each uses distinct compositions; the special technical feature of group III is not shared by group IV.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

With regard to applicants' Response to the Office Action mailed Oct. 3, 2002, the examiner agrees with applicants' arguments. However, applicants' presentation of a substitute page 67 has not been entered because it does not comply with the rules for amending an application (See 37 CFR 1.121). Applicants' need to provide a clean copy of the paragraph to be amended and a marked up version of said paragraph showing the changes made.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Guzo whose telephone number is (703) 308-1906. The examiner can normally be reached on Monday-Thursday from 8:00 AM to 5:30 PM. The examiner can also be reached on alternate Fridays.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Irem Yucel, can be reached on (703) 305-1998. The fax phone number for

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the organization where this application or proceeding is assigned is (703) 308-4242. Faxes may be sent directly to the examiner at (703) 746-5061.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

David Guzo
January 22, 2003


DAVID GUZO
PRIMARY EXAMINER